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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/037,916	03/10/1998	NOBUHIKO NISHIO	P8287-8002	7683

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/037,916

Applicant(s)

NISHIO ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

This is in response to an amendment file on October 15th, 2003 for letter for patent filed on March 10th, 1999. In the amendment, no claim has been amended. Claims 1-29 have been canceled, and claim 30-33 have been added. Claims 30-33 are pending in the letter.

Response to Arguments

1. Applicant's arguments with respect to claims 30-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 30 is objected to because of the following informalities: Applicant discloses in paragraph 6 lines 1 “when accessing at least one of the first purse area.” Examiner is unclear as to what applicant mean by at least one. Applicant is advised to delete “at least one” in order to overcome Examiner’s objection.
3. Claim 30 is objected to because of the following informalities: Applicant discloses in paragraph 9 and 10 lines 2, respectively “at least one of an electronic money payment transaction.” Examiner is unclear as to what applicant mean by at least one. Applicant is advised to delete “at least one” in order to overcome Examiner’s objection.

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4. Claim 32 is objected to because of the following informalities: Applicant discloses in paragraph 10, 12 and 14 lines 2, respectively “when accessing at least one of the first purse area.” Examiner is unclear as to what applicant mean by at least one. Applicant is advised to delete “at least one” in order to overcome Examiner’s objection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuler et al. (WO 90/15382) in view of Reily (US Patent No. 5,877,482).

7. As per claim 30, Schuler et al teach an IC card (*debit card with two zones of memory, 12*) (*see fig 1*), comprising a first purse (*first protected zone*) area storing electronic money (*unlimited amount of monetary funds*) a second purse (*second unprotected zone*) area storing electronic money (*stored monetary amount of funds*) (*see page 5 line 34-6 line 13*) a memory (*memory zone, 18*) including an access program (*access application zone, 42*) executing access control when accessing at least one of the first purse area and the second purse area (*control access to restricted area*), the access control including controlling startup of the security program, a processor executing the security program and the access program (*see page 8 lines*

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24-35) and a connection terminal (*connection*) solely through which the external apparatus (*vending machine 20, debit/credit terminal 22*) and the processor communicate information with each other, wherein the access program executes, using the security program and through ciphered communications via the connection terminal, at least one of an electronic money payment transaction (*transaction record zones*) specified by the external apparatus from the first purse area/second purse and an electronic money deposit transaction to the first purse area/second purse, when the external apparatus specifies the first purse area to be accessed (*see page 14 line 7-14 line 33*), and the access program executes, through the connection terminal and without using the security program, only an electronic money payment transaction from the second purse area, when the external apparatus does not specify any of the first purse area and the second purse area (*see page 14 line 7-14 line 33*). Schuler et al fail to teach a memory including a security program executing ciphering/deciphering information to be communicated with an external apparatus when accessing the first purse area. However, Reily teaches an inventive concept wherein a memory including a security program executing ciphering/deciphering information to be communicated with an external apparatus when accessing the first purse area (*see abstract, column 4 lines 29-56*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schuler et al's inventive concept to include Reily inventive concept of a memory including a security program executing ciphering/deciphering information to be communicated with an external apparatus when accessing the first purse area because this would have resolve problem with authentication, thus providing proof of transaction origination on the basis of physical card

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thereby improving the security, reliability, and practicability of electronic transaction involving IC card and personal identification number.

8. As per claim 31, Schuler et al the IC card wherein the access program allows the external apparatus to access the second purse area subsequently after the external apparatus accesses the first purse area, if the external apparatus is a permitted apparatus specified by the security program (*see page 14 line 7-14 line 33*).

9. As per claim 32, Schuler et al a transaction apparatus for carrying out transaction with an IC card (*debit card with two zones of memory, 12*) (*see fig 1*), wherein the IC card includes a first purse area (*first protected zone*) storing electronic money (*unlimited amount of money*), a second purse area (*second unprotected zone*) storing electronic money (*stored monetary amount of funds*) (*see page 5 line 34-6 line 13*), a memory (*memory zone, 18*) including an access program (*access application zone, 42*) executing access control (*control access to restricted area*) when accessing at least one of the first purse area and the second purse area, the access control including controlling startup of the security program (*see page 8 lines 24-35*), a processor executing the security program and the access program (*see page 8 lines 24-35*), and a connection (*connection*) terminal solely through which information is communicated, a card reader/writer (*debit/credit terminal 22*) communicating the information with the IC card via the connection terminal (*see fig 1*) an operation unit (*transaction zone, 42*) through which a user manually specifies at least one of the first purse area and the second purse area and an amount or amounts of money to be transferred to the at least one of the first purse area and the second purse

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area (*see page 14 line 7-14 line 33*) a processing unit executing a transfer program accessing an account to transfer electronic money from the account to the at least one of the first purse area and the second purse area, wherein the transfer program includes obtaining an authorization, from the IC card connected to the card reader/writer, to access the first purse area, and transferring the amount or amounts of electronic money to be transferred from the account to the specified at least one of the first purse area and the second purse area after the authorization is obtained (*see page 14 line 7-14 line 33*). Schuler et al fail to teach a memory including a security program executing ciphering/deciphering information to be communicated with an external apparatus when accessing the first purse area. However, Reily teaches an inventive concept wherein a memory including a security program executing ciphering/deciphering information to be communicated with an external apparatus when accessing the first purse area (*see abstract, column 4 lines 29-56*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schuler et al's inventive concept to include Reily inventive concept of a memory including a security program executing ciphering/deciphering information to be communicated with an external apparatus when accessing the first purse area because this would have resolve problem with authentication, thus providing proof of transaction origination on the basis of physical card thereby improving the security, reliability, and practicability of electronic transaction involving IC card and personal identification number.

10. As per claim 33, Schuler et al a transaction apparatus according further comprising a cash payment unit giving out cash to the user when a payment of the case is specified through the operation unit (*see page 14 line 7-14 line 33*).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

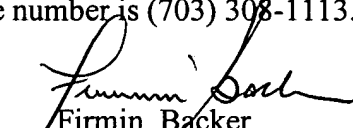
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
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December 2, 2003